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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pope Paul VI Institute for the Study of Human
Reproduction, Inc.

Serial No. 75/767,745

Denise C. Mazour of Zarley, McKee, Thomte, Voorhees & Sease
for Pope Paul VI Institute for the Study of Human
Reproduction, Inc.

Glenn G. Clark, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Cissel, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Pope Paul VI Institute for the Study of Human
Reproduction, Inc. (a Nebraska corporation) has appealed
from the final refusal of the Examining Attorney to
register on the Principal Register the mark FERTILITYCARE

for "educational services, namely, conducting classes in the field of reproductive medicine."¹

Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that when applicant's mark, as used in connection with the services identified in the application, is merely descriptive thereof.

Applicant and the Examining Attorney have filed briefs; an oral hearing was not requested.

The Examining Attorney essentially contends that the term "FERTILITYCARE" is a combination of the words "fertility" and "care," which immediately describes a significant feature of applicant's educational services, specifically, the subject matter of the classes. The Examining Attorney points to applicant's uses of the term "fertility" in its specimen of record; and in further support of the refusal to register, he submitted (i) dictionary definitions of the terms "fertility" and "care"; (ii) photocopies of several excerpted stories retrieved from the Nexis database relating to "fertility care"; and

¹ Application Serial No. 75/767,745, filed August 3, 1999, based on applicant's claimed date of first use and first use in commerce of 1998.

(iii) printouts of several web pages from the Internet, all including references to "fertility care."

Applicant urges reversal, contending that the Examining Attorney has not met his burden of establishing a prima facie case of mere descriptiveness in that the stories retrieved from the Nexis database and the printouts from Internet websites do not use the term "FERTILITYCARE" to immediately describe the educational services offered by applicant (conducting classes in the field of reproductive medicine); that the evidence does not show common usage of the term FERTILITYCARE by others for these educational services; and that applicant's unitary mark is suggestive and does not tell potential customers that the services are educational services. Applicant specifically criticized the Examining Attorney's evidence, asserting that some of the articles retrieved from the Nexis database refer to applicant and its use of the term "FERTILITYCARE," other articles show uses of the terms "fertility care" in foreign countries, and yet others relate to medical procedures and treatments devoted to infertility and performed by physicians, but do not relate to educational services.

The well-established test for determining whether a term or phrase is merely descriptive under Section 2(e)(1) of the Trademark Act is whether the term immediately

conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). The determination of mere descriptiveness must be made not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

The question is not whether someone presented with only the term or phrase could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

We look first to applicant's specimen of use -- an "advertisement" for applicant's services in the form of seven pages printed from applicant's website. The specimen includes the following statements:

The CREIGHTON MODEL FertilityCare System™ provides comprehensive, professional services through individualized follow-up, standardized teaching tools and ongoing research. The CREIGHTON MODEL is a standardized modification of the Billings Ovulation Method which meets the needs of a case management approach to teaching. It is the only education program in natural family planning which meets the educational demands of a newly emerging allied health profession. (page 1); and

Further eligibility criteria requires that the applicant(s) practice (use) natural family planning or, if single and celibate, monitor their natural fertility and be a philosophical acceptor of natural family planning. (page 2) (Bold emphasis omitted).

The specimen shows that applicant offers its educational classes to "practitioners" and "medical consultants" (e.g., registered nurses, physicians, physician assistants, nurse midwives) who meet certain eligibility requirements. The basic certificate programs of applicant's "CREIGHTON MODEL FertilityCare System™" include "The Practitioner Program," "The Medical Consultant Program," "The Practitioner/Medical Consultant (Combined)

Program," "The Instructor Program," "The Supervisor Program," and "The Educator Program."

In order to understand more fully applicant's services, we note the following additional references in the specimen:

...Physicians enrolled in the Medical Consultant Program should understand that the medical applications they will learn are related specifically to Creighton Model FertilityCare System. Thus, they should plan to have Creighton Model FertilityCare Practitioners available in their areas...." (Bold emphasis omitted.) (page 3 in the section titled "The Medical Consultant Program"); and

...As an instructors [sic], one may teach only under the supervision of a FertilityCare Practitioner...." (page 4 in the paragraph explaining "The Instructor Program.")

The relevant meanings of the words "fertility" and "care" have been made of record by the Examining Attorney in the following definitions from The American Heritage Dictionary of the English Language (Third Edition 1992):

"fertility" (noun) is defined as "1. The condition, quality or degree of being fertile..."; and

"care" (noun) is defined as "...7. Attentive assistance or treatment to those in need: a hospital that provides emergency care."

In addition, the Board takes judicial notice of Melloni's Illustrated Medical Dictionary (Fourth Edition 2002),² which defines the involved words as follows:

"fertility" is "the capacity to conceive and reproduce"; and

"care" is "general term used in medicine and public health to denote the application of knowledge to the benefit of an individual person or a community."

In the context of educational services, specifically conducting classes in the field of reproductive medicine, the words "fertility care" immediately convey information about the subject matter of the classes. The following are examples of the excerpted stories retrieved from the Nexis database showing use of the term "fertility care" (emphasis added):

HEADLINE: Health Events
...Dr. Billy Kutteh of the UT Medical Group gives a free 7 p.m. talk about advances in **fertility care**. Set for the Baptist Memorial Hospital East seminar room, it is sponsored by Resolve of Tennessee....., "The Commercial Appeal," (Memphis, TN), March 2, 1997;

HEADLINE: Health Digest
Infertility awareness seminar

² See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §712.01.

An infertility awareness seminar,
"**Fertility Care** in the '90s" will be
sponsored by the Miami Valley Hospital
Fertility Center from...., "The Dayton
Daily News," April 6, 1995;

HEADLINE: Drip, Drip, Drip
...developed new categories for
patients between ages 38 and 39 to
accurately document this drop in
patients under **fertility care** in the
country...., "The Tennessean,"
February 16, 1999;

HEADLINE: Insurance and Infertility
...The decision by Aetna Inc. and its
U.S. Healthcare plans to reverse the
policy of providing comprehensive
fertility care (front page, Jan. 10)
marks a sad day for infertile
couples...., "The New York Times,"
January 17, 1998; and

HEADLINE: Doctors Hope Babies Will Be
Fertile Business
...In addition, Horvath expects his
private practice to attract couples
who might otherwise leave the region
for **fertility care**, "The Times Union,"
(Albany, NY), May 15, 1997.

The Internet evidence submitted by the Examining
Attorney shows that the term "fertility care" is commonly
used by doctors in advertising their specialties, by
organizations in the field of reproductive medicine, and in
courses involving the topic of "fertility care" to refer to
a particular field of medicine, as shown in the following
examples (emphasis added):

Fertility Care In the Year 2000 and
Beyond

New Technological Developments in
Fertility Treatment

Moderated by: Lawrence B. Werlin, MD

Jointly Sponsored B:

Medical Education Collaborative, a
nonprofit education organization,
and Specialized Medical Management

The field of Reproductive medicine (**fertility care**) is one of the most rapidly changing fields of medicine...., "obgyn.net";

David Seifer, MD

...Peer Reviewed Publications

...The Transition to Office-Based **Fertility**

Care: A Guide for Reproductive Endocrinology

Fellows, NJ, Dowden Publishing Company,

2000...., "fertilityucref.com";

Albert Einstein College of Medicine,

Department of Obstetrics and Gynecology,

Organization of the Department,

...The woman member of a couple who needs ICSI

[Intracytoplasmic Sperm Injection] is often

more fertile than the average woman seeking

fertility care...., "aecom.yu.edu";

Murfreesboro Medical Clinic and Surgicenter,

The Department of Obstetrics and Gynecology...

"**Fertility care** may range from basic lifestyle

counseling to advanced artificial insemination

techniques...., "mmclinic.com";

Fertility Care Clinic with Catherine Chan N.D.

Welcome to the **Fertility Care** Clinic!

...The Fertility Program begins with a Pre-

Conception Detoxification Program...,

"care.cc";

Our [Advanced Reproductive Care, Inc.] goal is
to provide individualized **fertility care** to

every couple that is the highest quality, most
comprehensive, and most cost-effective

treatment available anywhere....,

"fertilitymrm.com"; and

Fertility care for cancer patients and survivors...(The Reproductive Specialty Center), "drary.com."

It is clear from the specimens that applicant offers its classes in "reproductive medicine" to medical personnel. However, importantly, there is no such restriction in the identification of services limiting the classes to students who are medical personnel. As identified, applicant's services could be offered to anyone interested in learning about reproductive medicine, including the general public.

It also appears from the specimens that applicant's classes relate to natural birth control methods, whereas the majority of the stories retrieved from Nexis as well as the various Internet websites apparently refer to essentially the opposite concept, i.e., infertility treatments. Under either concept (birth control methods or infertility treatments), the term "fertility care" is within the scope of applicant's identified classes on "reproductive medicine." We must consider applicant's services as identified in its application, and not the services actually offered in the marketplace. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

The Examining Attorney has established a prima facie case that the term "FERTILITYCARE" is merely descriptive of applicant's "educational services, namely, conducting classes in the field of reproductive medicine." The evidence shows that the general public, as well as medical professionals, would understand the wording FERTILITYCARE to refer to the topic of the class, not a source identifier of the entity offering the class.

We find that the term FERTILITYCARE immediately and directly conveys information about a significant feature of applicant's classes conducted in the field of reproductive medicine. The commonly understood English meaning of the words "fertility" and "care," presented as "fertilitycare," will be readily understood by the relevant purchasers as the subject matter of the class being offered.

The deletion of the space between these two words to combine them into one word does not create an incongruous or creative or unique mark. See *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

Rather, applicant's mark, FERTILITYCARE, when used in connection with applicant's identified services, immediately describes, without conjecture or speculation, a significant feature of applicant's goods. Nothing requires the exercise of imagination or mental processing or

gathering of further information in order for purchasers and prospective customers of applicant's services to readily perceive the merely descriptive significance of the term FERTILITYCARE as it pertains to applicant's service of conducting classes in the field of reproductive medicine. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). See also, *In re Institutional Investor, Inc.*, 229 USPQ 614 (TTAB 1986); *In re Industrial Relations Counselors, Inc.*, 224 USPQ 309 (TTAB 1984); *In re The BOC Group, Inc.*, 223 USPQ 462 (TTAB 1984); and *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984).

Decision: The refusal to register the mark because it is merely descriptive under Section 2(e)(1) is affirmed.